UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/848,846	05/19/2004	Theodore W. Neff	10980509-4	6960

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EXAMINER
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ART UNIT	PAPER NUMBER
2178	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	10/848,846	NEFF ET AL.
Office Action Summary	Examiner	Art Unit	
	DAVID FABER	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*19 May 2004*</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>*24-34*</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>*24-34*</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on <u>*19 May 2004*</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
        1.☐ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>*5/19/04*</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____ .

DETAILED ACTION

1.   This office action is in response to the application filed on 19 May 2004.

This office action is made Non-Final.

2.   This application is a continuation of App. 09/164975 filed 1 October 1998.

3.   Claims 1-23 have been cancelled by the Applicant.

4.   Claims 24-34 have been added.

5.   Claims 24-34 are pending. Claims 24 and 32 are independent claims.

Priority

6.   Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e)

or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

Information Disclosure Statement

7.   The information disclosure statement filed 19 May 2004 fails to comply with the

provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the Form PTO-1449 fails to

list the EPO Search Report provided with the IDS. Since the EPO Search Report

provided is not listed, it fails to comply with 37 CFR 1.98(a)(1), which requires the

following: (1) a list of all patents, publications, applications, or other information

submitted for consideration by the Office. In addition, one of the reference listed in

Other References fails to list it pertinent pages. It has been placed in the application

file, but the information referred to therein has not been considered as to the merits.

Applicant is advised that the date of any re-submission of any item of information

contained in this information disclosure statement or the submission of any missing

element(s) will be the date of submission for purposes of determining compliance with

the requirements based on the time of filing the statement, including all certification

requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Drawings

8.   The drawings were received on 19 May 2004. These drawings are accepted.

Claim Rejections - 35 USC § 102

9.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10.   Claims 24-27, 30, and 32-34 rejected under 35 U.S.C. 102(b) as being

anticipated by IBM ADF Color Scanner User's Guide (hereinafter IBM), including screen

shots of help files, July 1995 IBM Corporation, pp 1-22, screen shots pp 23-40, which

the Applicant provided in the Information Disclosure Statement filed 5/19/2004.

As per independent claim 24, IBM discloses a method comprising:

- displaying, by scanner software, preview scan data generated in response to

    a preview scan of the document; (pp.36-37: Discloses a prescan image of the

    document is displayed to the user in a "prescan window")

- selecting a region of interest in the preview scan data; (p 36 – Discloses square box inside the prescan window that outlines the part of the prescanned image you wish to scan)

- presenting, from scanner software to an application software, one or more data formats for the selected region of interest; receiving selection, by the application software, of one of the one or more data formats; (p 37 – disclose the option of the file format being bitmap. In addition, p35, p39 and p40 discloses the user has the ability to select and choose which file format to save the scan to using the file save settings option, wherein after the user selects the file format, the user clicks ok button to input the selection wherein the selection is received when the ok button is clicked. (p40)

- launching a second scan of the document; and storing data relating to the second scan of the document in the selected one data format. (p37 – After the user selects the area the user wishes to scan from the prescan, the user clicks the OK button which will scan the document wherein it is implicit that within the scanner software operating in a computer environment will store the final scanned image within a memory of a computer specified by the user using the file save settings (p40))

As per dependent claim 25, IBM discloses:

- the scanner software determining a data type of the selected region of interest; and (p37 Item Scan Mode - discloses the 255 gray scale (gray) image data type

- the scanner software presenting the one or more data formats associated with the determined data type. (p37 – discloses file format bitmap (.bmp) It is implicitly known in the art that known image formats of .bmp supports 255 shaded gray scale image data)

As per dependent claim 26, IBM discloses receiving user input indicating selection of the application software; and in response to the user input indicating selection of the application software, the application software receiving the presented one or more data formats. (p35 – The user has the ability to specify to export the scan image to a application, wherein the user needs to choose the file format and scan mode that the application. Thus, the user has the ability to select and input the file format to the computer to save the final scan using file save format. (p37, p40))

As per dependent claim 27, IBM discloses the application software determining whether any one of the presented one or more data formats is acceptable to the application software; and in response to the application software determining that any one of the presented one or more data formats is acceptable, the application software notifying the scanner software that the application software is able to receive scan data. (p35 - Discloses that certain applications implicitly know which file formats and scan

modes to accept. For example, Windows Paintbrush only accepts bmp and certain scan

modes stored as pcx file formats, not tiff format.)

As per dependent claim 30, IBM discloses:

displaying a window for the application software; (p37 – Discloses application

software window)

receiving user input indicating that the selected region of interest is to be moved

to the window for the application software, (pg 36-37: Discloses the user adjust and

move the squared, outline box inside the prescan window that outlines the part of the

prescanned image you wish to scan)

wherein receiving the selection of the one or more data formats and launching

the second scan are performed in response to the user input. (The user has the ability

to select and input the file format to the computer to save the final scan using file save

format. (p37, p40) Once selected, the user clicks the OK button which will scan the

document)

As per independent claim 32, Claim 32 recites similar limitations as in Claim 24,

and is similarly rejected under rationale. Furthermore, IBM discloses a monitor, (p24. In

addition, it is inherent that in order for a user to view the displayed windows and

graphical user interface, a monitor must be presented)

As per dependent claim 33, Claim 33 recites similar limitations as in Claim 25,

and is similarly rejected under rationale.

As per dependent claim 34, Claim 34 recites similar limitations as in Claim 27,

and is similarly rejected under rationale.

Claim Rejections - 35 USC § 103

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

12.   Claims 28-29, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable

over IBM ADF Color Scanner User's Guide (hereinafter IBM), including screen shots of

help files, July 1995 IBM Corporation, pp 1-22, screen shots pp 23-40, which the

Applicant provided in the Information Disclosure Statement filed 5/19/2004..

As per claim 28, IBM fails to specifically disclose in response to the application

software determining that none of the one or more data formats is acceptable, the

application soft-ware causing presentation of an indicator that receipt of scan data is not

allowed. However, it was well known to one of ordinary skill in the art at the time of

Applicant's invention of an error message popping up (i.e. alert box) on the screen

indicating an error has occur when file formats are not compatible with an application. It

would have been obvious to one of ordinary skill in the art at the time of Applicant's

invention to have modified IBM's scanning software with error messages since it

provides an efficient and immediate response notifying a unexpected condition has

occurred when the condition occur for the user to consider.

As per dependent claim 29, IBM discloses receiving a input at a location on the displayed preview scan data; and evaluating preview scan data around the location of the input to identify the region of interest. (Pg 36 – Discloses the user has the ability to adjust and move a outlined squared box inside the window to indicate and designate the part of the prescanned image that the user wishes to scan. Pg 37- shows the visual example of the box in the window of the prescanned image.) However, IBM fails to specifically disclose a click input. However, IBM discloses user selection of application settings before a final scan commences using a mouse (pg 18-19) wherein the use of a moue for selecting is well known in the software art.

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified IBM's scanning software with the a use of a mouse since it provides the user with a quick, simple and efficient of finding, point and selecting an items on the screen.

As per dependent claim 31, Claim 31 recites similar limitations as in Claim 30, and is similarly rejected under rationale. Furthermore, IBM discloses

- displaying a desktop on a computer; (According to page 13, line 24, the Applicant defines the desktop is an open application. Therefore p18 Defining a Scan and Save Action, Windows Paintbrush),

- receiving user input indicating that the selected region of interest is to be moved to the desktop, (p35, p37-p38 –IBM teaches of exporting the selected image within the outlined box from the prescanned window, from the software scanner, to another application.

However, IBM fails to specifically disclose displaying an icon representing the

data relating to the second scan in the desktop. However, the limitation of displaying an

icon representing the data relating to the second scan in the desktop is well-known in

the software art as being implemented by Windows Explorer within Windows 95

operating system wherein the functionality of displayed icons provides the benefit of a

simple, quick, and ease of use aid in assisting the organization of files in a visual

manner through a graphical user interface.

Double Patenting

13.   The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees.   A nonstatutory
obviousness-type double patenting rejection is appropriate where the conflicting claims
are not identical, but at least one examined application claim is not patentably distinct
from the reference claim(s) because the examined application claim is either anticipated
by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140
F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29
USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.
1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422
F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163
USPQ 644 (CCPA 1969).
        A timely filed terminal disclaimer in compliance with 37 CFR 1.321© or 1.321(d)
may be used to overcome an actual or provisional rejection based on a nonstatutory
double patenting ground provided the conflicting application or patent either is shown to
be commonly owned with this application, or claims an invention made as a result of
activities undertaken within the scope of a joint research agreement.
        Effective January 1, 1994, a registered attorney or agent of record may sign a
terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with
37 CFR 3.73(b).
14.   Claims 24-34 rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6751780.

Although the conflicting claims are not identical, they are not patentably distinct from

each other because they are substantially similar in scope and they use the same

limitations, using varying terminology.

Conclusion

15.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

- Arakawa (US Patents 6188807, 6532077) Discloses prescanning an image
  with a scanner.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to David Faber whose telephone number is 571-272-2751.

The examiner can normally be reached on M-F from 8am to 430pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen Hong, can be reached on 571-272-4124. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

/David Faber/
Examiner, Art Unit 2178

/CESAR B PAULA/

Primary Examiner, Art Unit 2178